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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/895,493 07/16/97 SAITO

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022804
HECKER & HARRIMAN
1925 CENTURY PARK EAST
SUITE 2300
LOS ANGELES CA 90067

TM02/0111

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EXAMINER

SEAL I	
ART UNIT	PAPER NUMBER

[Handwritten mark]

2131
DATE MAILED:
01/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.
08/895,493

Applicant(s)

Salto

Examiner

James Seal

Group Art Unit

2766

☒ Responsive to communication(s) filed on 1 Nov 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 95-152 is/are pending in the application

Of the above, claim(s) the claims listed in paragraph 6 as previously non-elect is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) All examined claims is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 95-152 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. This action is a response to your correspondence of 1 November 2000
2. Amended claims 95 and 111, and 127 have been entered and approved.
3. New claims
4. Previous Office actions are incorporated herein.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Information Regarding the Election/Restriction Requirement

6. The current Application is a CPA of the parent application wherein an election requirement was maintained. In the parent application, a provisional election was made, *without traverse*, to prosecute the invention of Species I. Subsequently examination was carried out on generic claims along with the elected Species I. Applicants confirmed the election of Species I in their response to a USPTO office action on 7-17-1997.

The CPA application does not indicate that a change in election is desired. The election in the parent application therefore is carried into the CPA. See, M.P.E.P. 819.

Claims 96, 98, 100, 102, 106, 108, 112, 114, 116, 118, 122, 124, 128, 130, 132, 134, 138, and 140 are, *therefore, withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected species.*

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7. This application contains claims 96, 98, 100, 102, 106, 108, 112, 114, 116, 118, 122, 124, 128, 130, 132, 134, 138, and 140, which are drawn to an invention nonelected without traverse in Paper No. 18. *Applicant is reminded* that a complete reply to the final rejection, *must* include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP 821.01.

Docketing

8. Please note that the application has been redocketed to a different examiner. Please refer all future communications regarding this application to the examiner of record, using the information supplied in the final section of the office action.

Claim Rejections - 35 USC § 112

9. Rejection of claims 95, 97, 99, 101, 103-105, 107, 109-111, 115, 117, 119-121, 123, 125, and 126 under 35 U.S.C. 112 second paragraph for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention are withdrawn. With amendments to claim 95 and claim 111, the claims now recite actions of storing, copying and/or transferring without reference to a single key.

10. Rejection of claims 127, 129, 131, 133, 135-137, and 139 under 35 U.S.C. 112 second paragraph is withdrawn. Amendment of claim 127 now specifies a single key control center which defines the invention. Further replacing “encrypting ... decrypted data again to be stored” with “encrypting ... decrypted data again and storing ...”; “encrypting ... decrypted data again to

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be copied” with ““encrypting ... decrypted data again and storing”; and “encrypting ... decrypted data again to be transferred” with “encrypting ... decrypted data again and transferring” cures the that this limitation was not positively recited. It is now evident that the “again” refers to encryption.

Substitute Specification

11. Applicant seems to believe that the substitute specification merely needs to “incorporate the amendments” previously submitted. This is not the case. See the statement of the requirement in previous action.

12. The Examiner acknowledges Applicant’s desire to defer preparing a substitute specification until such time as Allowable Subject matter has been identified. The Examiner has no problem with this in principle. However, Applicant should be aware that deferring such a submission may result in delayed issuance of the patent owing to the new expedited procedures for issuing patents.

Claim Rejections - 35 USC § 102 and § 103

13. Rejection of Claims 95, 97, 99, 101, 103, 104, 127, 129, 131, 133, 135, and 136 under 35 U.S.C. 102(e) as being anticipated by Dolphin (5457746) is maintained.

14. Rejection of califs 105, 107, 109, 110, 137, 139, 141, and 142 under 35 U.S.C. 103 as being unpatentable over Dolphin in View of Daniele (5,444,779) is maintained.

15. Rejection of claims 111, 113, 115, 117, 119, and 120 under 35 U.S.C. 103 as being unpatentable over Dolphin and what is well known in the art, is maintained.

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16. Rejection of claims under 121, 123, 125, and 126 under 35 U.S.C. 103 as being unpatentable over as applied to claim 115 above, and further in view of Daniele is maintained.

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sasamoto et. al. ('969) shows that data is only stored in re-encrypted form and Morishita et. al. ('175) discloses a software copyright management system.

18. Claims 143-152 are rejected under 35 U.S.C. 103 as being unpatentable over Dolphin and what is well known in the art.

19. In claims 143-147 applicant recites a method with the limitations of claim 95 and the further limitation that the display, edit, store, or transfer digital data (that is access and manipulation of data files) subject to a permit key.

20. Dolphin discloses a subscription encrypted/decrypted system which a request to access to files for manipulation can denied access to display if authentication is not validated. It is well known in the art of computer processing that access to computer files means the ability to display, edit, store or transfer data. If authentication is validated, key is then provided and access to file is granted (figure 13). Claims 143-147 are rejected.

21. In claim 148, applicant recites a method with the limitations of claim 111 with the further limitation that display of decrypted digital data is subject to a permit key.

22. Dolphin discloses a system with key control of information displayed. See above. Claim 148 is rejected.

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23. In claims 149-152, applicant recites a method with the limitations of claim 111 with the further limitation that prohibits the storage, copying, or transfer of decrypted digital data, but permits storing, copying or transfer of encrypted data.

24. Dolphin discloses a subscription encrypted/decrypted system which a request to access to files for manipulation can denied access to display if authentication is not validated. It is well known in the art of computer processing that access to computer files means the ability to display, edit, store or transfer data. If authentication is validated, key is then provided and access to file is granted (figure 13). Further the data in decrypted form might become accessible to unauthorized persons. Thus to protect from this possibility, one skilled in the art would limit access by only allowing storing, copying or transfer of encrypted data. An authorized person would have the means to decrypt the data, but encrypted files preclude persons without authorization access to the files. Claim 149-152 are rejected.

Response to Arguments

25. Applicant's arguments filed on 1 November 2000 have been fully considered. Note that new rejections have been entered because of the amendments to the claims.

26. Applicant contends that Dolphin does not disclose the presently claimed "copyright control program".

27. Dolphin teaches a system that supplies encrypted data (22 in Figure 1) to a user in response to a user's request (27' in Fig. 2) a key control center (23 of Figs. 1 and 2) supplies crypt key to the user (27" in Fig. 2); the user displays the data after decryption by the decrypt key (see,

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e.g., Column 6, lines 54-58, note that user 26 has a computer 31 which includes a monitor to display the data--which "can include, for example video, image, photographs, databases, sound, [and] software" (Column 5, line 17-18). The system may be used as database access control/billing (royalties) for corporate, government or legal information in-house, validating user requests by authentication, using digital signature (Column 7 lines 59-67)). "This feature avoids piracy of *copyrighted material*, as well as falsified records in corporate, government and legal environments" (Column 9 lines 4-7). Thus Dolphin provides a system including the programs to prevent piracy of copyrighted material as well as collecting royalties (billing) and other information prescribed by law, as well as provide access for legitimate users. This is a copyright management program.

28. Applicant contends that Dolphin does not teach re-encrypting prior to storing, copying, or transferring of data. As mentioned previously Dolphin's concern is to "prevent piracy of copyrighted material", however, if decrypted data may be copied, stored, or transferred at the user site, the publisher of this information loses control over the data and would thus allow unauthorized persons to obtain access to such material. One skilled in the art would recognize that such data must not be allowed to be copied, transferred, or stored in an unencrypted form, and thus would have encrypted decrypted data before copying, storage or transfer took place.

29. Applicant contends that Daniele, while a copyright management program, also discloses additional features not claimed in 105, 107, 109, 110, 137, 139, 141, and 142.

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30. The claim language states that the “a method ... further comprising” and thus does not limit the claims to those features.

31. The applicant further contents that his invention plus the Daniel’s glyph would be “technological unreasonable”.

32. The applicant has reversed the standard for a 103. It is not the case that one compares applicant’s invention plus some extra piece to get Dolphin and Daniele and then argue it is technologically unreasonable to do this, one has to argue that one of average skill in the art would have found it obvious to add a feature of Daniele to Dolphin to obtain the applicant’s invention.

33. Dolphin discloses a copyright management program, but does not disclose the details. Daniele [see for example, 8, 56 - 9,25] teaches modifying the copyright control glyph to indicate the status and history of the document for auditing and tracking or royalty information and accounting. Thus one of ordinary skill in the art would be motivated to combine the teachings of Dolphin and Daniels in order to obtain the specifics of the copyright management program.

34. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

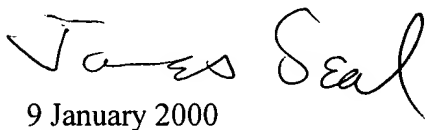
Conclusion

35. Any inquiry concerning this communication should be direct to James Seal at telephone number (703) 308 4562. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 5:30 p.m.

36. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes, can be reached at (703) 305-9711.

37. Any inquiry of a general nature or relating to the status of this application or preceding should be directed to the Group receptionist, whose telephone number is (703) 305-3800. Fax number is (703) 305 0040.

James Seal


9 January 2000


GAIL HAYES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100